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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,406	11/28/2003	Miyuki Tanaka	245996US0	7403

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C. IRVIN MCCLELLAND  
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.  
1940 DUKE STREET  
ALEXANDRIA, VA 22314

EXAMINER
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PENG, KUO LIANG

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/722,406	<b>Applicant(s)</b> TANAKA ET AL.	
	<b>Examiner</b> Kuo-Liang Peng	<b>Art Unit</b> 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 7/12/06 Amendment.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4,5,12-14 and 16-18 is/are rejected.
- 7) ☒ Claim(s) 2,3,6-11 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The Applicants' amendment filed on July 12, 2006 is acknowledged. Claim 1 is amended. Claims 3-18 are added. Now, Claims 1-18 are pending.
2. The text of those sections of Title 35, U.S. code not included in this action can be found in prior Office Action(s).

#### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 12-13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 12 (line 2), it is not clear as to how low the "lower" in "lower alkenyl group" refers to.

#### ***Claim Rejections - 35 USC § 102***

5. Claims 1, 5, 12-14 and 16-18 are rejected under 35 U.S.C. 102(b) as being unpatentable over Sumpter (US 5 331 075).

Sumpter discloses a silicone composition comprising a **vinyl organopolysiloxane fluid**, a silicon hydride siloxane and a platinum catalyst system. The platinum catalyst system can contain a platinum and **indazole**. The amounts of the platinum and the indazole are described in col. 3, lines 3-17 and col. 6, lines 39-44. The composition does not contain cyclic siloxane fractions of D3 to D10. Sumpter teaches that the vinyl organopolysiloxane fluid is **preferably** a **vinyl end-capped linear** polydiorganosiloxane represented by formula (2). (col. 3, line 43 to col. 4, line 40) As such, Sumpter does teach the **less preferable** vinyl organopolysiloxane fluid that are those end-capped with triorganosiloxy groups or those containing branched moieties. Since Sumpter's silicone composition is substantially the same as that of Applicants', both should have the same properties such as transparency, flame retardancy, etc. *In re Best*, 195 USPQ 430 (CCPA 1977). As such, Sumpter's silicone composition should be capable of being used for preparing an integrated circuit.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

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matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4, 12-14 and 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wong (US 4 720 431) in view of Palensky (US 4 511 715).

Wong discloses a silicone composition comprising A) a hydrido-containing polysiloxane, B) an alkenyl group-containing polysiloxane and an organic-platinum catalyst. (col. 1, line 36 to col. 2, line 12) The crosslinking reaction between A) and B) occurs in the chain of component B) (i.e., the chain ends of component B) are blocked by triorganosiloxy group)(col. 2, line 46 to col. 3, line 24) The composition can be used for integrated circuit devices. (col. 1, lines 12-33 and 51-61) The composition does not contain cyclic siloxane fractions of D3 to D10. Wong is silent on the use of the specific component D) set forth in the present invention. However, Palensky teaches the use of a platinum catalyst system containing a platinum and a nitrogen compound such as **imidazole**. (col. 2, lines 3-47, col. 6, lines 40-44, col. 8, lines 26-38 and Example 4) The motivation of using the platinum/imidazole catalyst is to enhance the stability, etc. of the composition. (col. 2, lines 35-44) In light of the benefit mentioned, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to utilize

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Palensky's platinum/imidazole catalyst in Wong's composition with expected success.

6. Claims 2-3, 6-11 and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Sumpter does not teach or fairly suggest the specific component D) set forth in the instant claims.

7. Claims 12-13 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

The patentability of the instant claims is described above.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuo-Liang Peng whose telephone number is (571) 272-1091. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on (571) 272-1302. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

klp  
September 8, 2006

  
Kuo-Liang Peng  
Primary Examiner  
Art Unit 1712